

**Notice of Allowability**

Application No.

10/730,575

Applicant(s)

COHENFORD, MENASHI A.

Examiner

Samuel Woolwine

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the brief filed 08/07/2007.
2. ☒ The allowed claim(s) is/are 3-16 and 18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |   |
|--|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 5. <input type="checkbox"/> Notice of Informal Patent Application                     |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date _____    | 7. <input type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|  | 9. <input type="checkbox"/> Other _____   |

/Young J. Kim/  
Primary Examiner  
Art Unit 1637  
Technology Center 1600

### REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: the rejection of claims 3-16 and 18 over Richards (US 5,645,987) in view of Kurn (US 6,251,639) and Kacian (US 5,916,777) are withdrawn in view of Applicant's arguments presented in the brief filed 08/07/2007, which upon further consideration are found persuasive. In particular, Applicant's invention includes the feature of a template (i.e. "triggering template") being cleaved, and a portion of the cleaved template being used as a primer in a further step. Richards, on the other hand, cleaves a portion of the extended primer, not the template, and uses the cleaved portion of the extended primer as a primer in a further step. There was no apparent reason why one of skill in the art would modify Richards' method to cleave off a portion of the template for subsequent use as a primer.

The examiner would also make of record two similar disclosures. Sorge (US 6,893,819) discloses a method in which extension of a first primer along a template results in cleavage of an oligonucleotide annealed on the template downstream of the first primer. A portion of the cleaved oligonucleotide is then used as a primer in a subsequent reaction. Seibl et al (US 5,783,392) discloses a method in which an oligonucleotide is annealed to a target. A portion of the oligonucleotide is cleaved by RNase H, and the cleaved portion is subsequently used as a primer in an extension. The extended primer is then annealed to a second target and cleaved by RNase H, and the cleaved portion may then be used as a primer in a further reaction, and so on. However, as with Richards, neither Sorge nor Seibl teaches cleaving the *template* in a

Art Unit: 1637

primer extension reaction, and there was no apparent reason to modify these prior art methods to do so.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Woolwine whose telephone number is (571) 272-1144. The examiner can normally be reached on Mon-Fri 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

scw

/Young J. Kim/  
Primary Examiner  
Art Unit 1637  
Technology Center 1600